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Docket 83194F-P  
Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Christopher C. Cegelski, et al

ALBUM LEAF WITH INSERT

Serial No. 09/973,031

Filed October 09, 2001

Group Art Unit: 3722

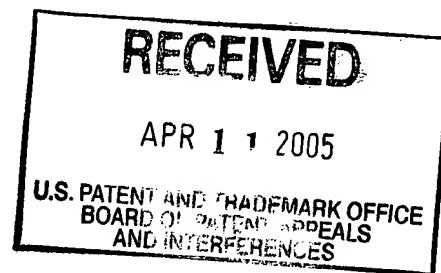
Examiner: Mark T. Henderson

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Sir:

**APPEAL BRIEF TRANSMITTAL**

In response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) dated March 7, 2005, resubmitted herewith, in triplicate, is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Sir:

**APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192**

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## **APPELLANT'S BRIEF ON APPEAL**

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of December 24, 2003 of claims 1, 3-12, 32 and 33 which was contained in the Office Action mailed February 24, 2004 and the Office Action dated

A timely Notice of Appeal was filed March 25, 2004.

### **Real Party In Interest**

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

### **Related Appeals And Interferences**

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

### **Status Of The Claims**

Claims 1, 3-12, 32 and 33 have been rejected and are pending.

Claim 2 has been cancelled.

Claims 13-31 have been withdrawn.

Appendix I provides a clean, double spaced copy of the claims on appeal.

### **Status Of Amendments**

All amendments have been entered and the claims stand as indicated in Appendix I.

### **Summary Of The Invention**

The present invention is directed to an image product assembly that includes a dual sided album leaf 12 having a first ply layer 14 and a second ply layer 16 each having an outer surface and an inner surface. The first and second ply layers 14, 16 form a pocket 23 for receiving an insert 24. The first and second ply layers 14, 16 have a plurality of images 30, 32, 44, 46, 48 formed thereon (see figures 2A and 2B). The insert 24 has a size and configuration such that it can be placed within the pocket 23, and has information 41, 43, 45, 47 and 49 as

illustrated in Figures 2A and 2B. The information relates to specific individual images of the plurality of images. The information on the insert is located in a position on said insert such that it can be readily identified with respect to which of the plurality of images it is associated with as illustrated by numerals 40, 42, 51, 53 and 55.

### **Issues For Review By The Board**

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether the drawings fail to disclose structural detail that essential for a proper understanding of the invention under 37 CFR 1.83.
2. Whether claim 33 fails to meet the requirements of 35 USC § 112 for containing subject matter not described in the specification.
3. Whether claims 1, 3-6, 12, 32 and 33 are unpatentable under 35 USC § 103(a) over U.S. Patent 370,186 to Fountain.
4. Whether claim 7 is unpatentable under 35 USC § 103(a) as being unpatentable over U.S. Patent 370,186 to Fountain in view of Young (U.S. 6,061,938).
5. Whether claims 8-11 are unpatentable under 35 USC § 103(a) as being unpatentable over Fountain in view of U.S. Patent 3,848,348 to Hawley.

### **Grouping Of Claims**

Group I:	Claims 1, 4, 5, 6, 8, 9, 10, 11, 12
Group II:	Claims 3, 32, 33
Group III:	Claim 7

### **Arguments**

#### ***Objection to the drawings***

In the Office dated August 25, 2004, objection to the drawings for failing "to show a ply layer not having any images thereon, however the images (30 and

32) are now printed on the insert alone as described in the specification (page 7, lines 15-17)". The Examiner argues that any structural detail that is essential for a proper understanding of the disclosed invention must be disclosed. Claim 1 specifically states "said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated." In this regard the embodiment illustrated in Fig. 2C described at the passage identified by the Examiner illustrated an embodiment where the information is provided over an image having a lower saturation (intensity). In this embodiment illustrated it is the lower intensity images that identifies which image the information is associated therewith provided on the claimed Album leaf. Applicant is not required to show every conceivable embodiment of the claimed invention, but simply at least one embodiment that supports the claimed invention. Applicants respectfully submit that drawings do indeed disclose appropriate structural detail of the claimed invention. There is no reason to show an insert without an image. The claimed invention requires that **"said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated"**. The drawings clearly provide such support.

### ***The Rejection***

Under 35 USC 112

The Examiner, in paragraph 3 of the Office Action dated August 25, 2004, rejected claim 33 under 35 USC § 112, as containing subject matter not described in the specification. In particular, the Examiner states "Claim 33, which is dependent on Claim 1, discloses wherein the insert further 'includes a low resolution or intensity image copy of the original image provided on the first or second ply layer'". The Examiner goes on to state that the specification at page 7, lines 15-17 argues that the specification does not support this. In this regard, Applicant refers the Examiner to page 11, lines 31 to page 12, line 1 where

Applicant refers to FIG. 2C and states that there is provided a low resolution or intensity image copy of the original image provided on the insert. This, in conjunction with the passages cited at page 7, clearly support the providing of the limitation as currently set forth in claim 33. Applicant respectfully submits the claims are adequately supported by the specification and meet all the requirements of 35 USC § 112.

Under 35 USC 103.

*Group I: Claims 1, 4, 5, 6, 8, 9, 10, 11, 12*

- A. The Examiner, in the Official Action dated December 24, 2003 rejected claims 1, 3-6, 12, 32 and 33 under 35 USC § 103 as being unpatentable over Fountain.

Claim 1 of the present invention is directed to a very specific product, in particular, it is directed to a dual sided album leaf having a first ply layer and a second ply layer each having an outer surface and an inner surface. The first and second ply layers are secured together so as to form a pocket there between. In addition, the outer surface of the first and/or second ply layer have a plurality of images formed thereon. Claim 1 further includes an insert having a size and configuration such that it can be placed within the pocket and has information thereon that relates to the plurality of images. In addition, the information on the insert is located in a position on the insert such that it can be readily identified with respect to which of the plurality of images it is associated. Applicants respectfully submit that the Fountain reference does not teach or suggest the invention as set forth by Applicants.

The Examiner, in the "Response to Argument" section of the Final Rejection dated 12/24/03 states that the Fountain reference is cited for disclosing an image placed on an insert wherein the insert further discloses information correlated to the image. The Examiner has further stated:

"[it] would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art."

The Examiner then cites *St. Regis Paper Co. v. Bemis Co.* for support that mere duplication of the essential working parts of a device involves only routine skill in the art and therefore it would have been obvious to include as many images as desired.

However, applicants respectfully submit that the Examiner has failed to appreciate the essential working parts of the present invention. The present invention is directed to providing a plurality of images on an album leaf with an insert providing information with respect to the image. The Fountain reference does not teach or suggest providing a plurality of images. Fountain discloses providing only a single image and providing biographical information with respect to the image. Furthermore, the information of the present invention that is provided on the insert is located such that the information can be readily identified with respect to which of the plurality of images it is associated. In the present invention, the fact that there are a plurality of images requires that the information provided can be readily related to its associated image. Since the Fountain reference does not disclose more than one image, Fountain could not address the problem to which the present invention is directed, that is, providing of information with respect to more than one image on an insert and associating that information so that it can be readily identified with respect to the image it is associated, therefore, providing the appropriate information with respect to its associated image.

The CAFC stated in *In Re Lee* 277 Fed 3<sup>rd</sup> 1330 (61 USPQ 2<sup>nd</sup> 1430) 2002 “the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record.” The court at 1443 stated “(our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references)”. The Court goes on to state “(there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant)”. The Court at 1443 stated “only by showing some objective teaching in the prior art or that knowledge generally



available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”.

In the present situation, the Fountain reference does not teach or suggest providing multiple images or associating specific information with each of the plurality of images. The Examiner merely relies on the fact that in the Examiner’s opinion it would be obvious to modify and provide as many images as desired. Even if one were to put more than one image as suggested by the Examiner, there is still no teaching or suggestion of providing information in a location such that it can be readily identified with respect to which of the plurality of images it is associated. Thus, the Examiner has failed to show:

- 1) motivation to modify or provide more than one image;
- 2) providing information for each image at a location such that the information can be readily identified with respect to which image it is associated.

The Examiner states correctly that when printed matter is not functional it will not distinguish the invention from the prior art in terms of patentability. In this regard, Applicants have clearly demonstrated the functionality of the information provided. The present invention does not simply claim printed matter, it claims that the printed matter is located at a position such that it can be readily identified with respect to which of the plurality of images it is associated. This is a functional relationship between the printed matter on the insert and the particular image it is associated therewith on the album leaf. The printed matter has a location on the insert that gives it functionality. The Examiner appears to argue that printed matter (such as size, dimension) is not the kind of functionality necessary for patentability. However, it is not mere size of the print to which the functionality of the printed matter in the present invention applies, it is the location of the various information on the insert and its relationship to the images that provides the functional relationship. Thus, it is respectfully submitted that claim 1 is patentable over Fountain. The remaining claims in this group depend at least ultimately upon independent claim 1 and are therefore also patentable for the same reason. The Hawley reference cited against claim 8 (which is dependent upon claim 1) does not teach or suggest anything that would render claim 1 unpatentable.

*Group II: Claims 3, 32, 33*

B. These claims have been rejected as being unpatentable over the Fountain reference. The claims in Group II set forth specific ways in which the information can be readily associated and identified with respect to which image is to be associated. As previously discussed, the Fountain reference does not teach or suggest more than one image and therefore could not face the problem of associating different types of information with different images to which the present invention is directed. Further, claim 3 includes the limitation that the information is correlated with the image by providing a smaller image of a reduced visual characteristic as shown. Claim 32 sets forth that an outline copy of the associated image is provided at a lower resolution (see Fig. 2C and specification at page 7, lines 10-24) for correlation of the information with the images. Applicants respectfully submit that the prior art fails to disclose any of the above limitation of these claims. Therefore, Fountain could not teach or suggest the invention as set forth by these claims.

*Group III: Claim 7*

C. The Examiner rejected claim 7 over Fountain. Group III contains only a single dependent claim, claim 7, which is dependent upon independent claim 1 and includes the additional limitation wherein the insert is folded for retaining of the insert within the pocket. Clearly the Fountain reference does not teach or suggest such a structure and therefore could not render obvious dependent claim 7. The Examiner has cited Young as disclosing a slidable foldable insert that when placed in a pocket allows it to be retained. However, it is not the folded insert that causes it to be retained, it is the shoulder-engaging extension 50 and the V-shaped insert 32 as shown in Figure 4 for limiting movement of the V-shaped insert toward the retracted position. See Column 4, lines 36-39. This is in contrast wherein it's the actual folded insert that results in it being retained and not some V-shaped limiting member.

Accordingly, it is respectfully submitted that Fountain in view of Young could not teach or suggest the invention as taught and claimed by Applicants.

**Summary**

In summary, Applicants respectfully submit that the claims in the present invention are patentably distinct over the cited prior art.

## **Conclusion**

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of the Claims.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Frank Pincelli", is written over a horizontal line.

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Enclosures

## **Appendix I - Claims on Appeal**

1. An image product assembly, comprising:  
a dual sided album leaf having a first ply layer and a second ply layer, said first and second ply layers each having an outer surface and an inner surface, said first and second ply layers are secured together so as to form a pocket there between, said outer surface of said first and/or second ply layer having a plurality of images formed thereon; and  
an insert having a size and configuration such that it can be placed within said pocket, said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated.
3. An image product assembly according to claim 2, wherein said information is correlated with respect to its associated image by providing a size of said associated image at a reduced size having reduced visual characteristics.
4. An image product assembly according to claim 1, wherein said outer surface of said first and second ply each have a plurality of images and said insert having information with respect to said images on said first and second surfaces, said information being provided on said insert.

5. An image product assembly according to claim 1, wherein said insert is provided with a retaining member that prevents the insert from being pulled completely out of said pocket.

6. An image product assembly according to claim 5, wherein said retaining member comprises a pair of restraining tabs disposed at opposite ends of said insert, the restraining tabs being designed to be stopped by a retaining section in said leaf.

7. An image product assembly according to claim 1 wherein insert is folded such that when it is placed within said pocket it causes said insert to be retained within said pocket.

8. An image product assembly according to claim 1, wherein said first and second ply layers each comprise four sides and said first and second ply layers are secured together along three of said four sides.

9. An image product assembly according to claim 8, wherein an adhesive is used to secure said first and second ply layers together.

10. An image product assembly according to claim 8, wherein a generally u-shaped member is positioned along three of said four sides is provided for securing said first and second ply layers together.

11. An image product assembly according to claim 10, wherein an adhesive is applied to the inner surface of said first and second ply layers.

12. An image product assembly according to claim 1, wherein said first and second ply layers are formed by folding a single sheet.

32. (Original) An image product assembly according to claim 1 wherein said information is correlated with respect to associated image by providing an outline copy of set associated image on said insert.

33. (Original) An image product assembly according claim 1 wherein said insert includes a low resolution or intensity image copy of the original image provided on said first ply layer or second ply layer.